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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,711	08/08/2002	Scott C. Harris	Broadband/SCH	8484
23844	7590	04/28/2005	EXAMINER	
SCOTT C HARRIS			D AGOSTA, STEPHEN M	
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SAN DIEGO, CA 92192			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/064,711	HARRIS, SCOTT C.	
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 November 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3-2-05 have been fully considered but they are not persuasive.

1. The applicant has not addressed the primary examiner's objection to figure 1 with regarding to it requiring a Prior Art label. This objection has not been overcome.

2. The applicant's amendment to claim 1 overcomes the primary examiner's objection.

3. The applicant argues that the prior art does not teach a cellular phone. The primary examiner broadly interprets Moon's portable/mobile device (figure 1) as reading on a cell phone since it transmits data wirelessly via RF/cellular means. Moons device is a combination "phone/computer" (eg. PDA) which is well known in the art. Hence Moon's phone/computer controls a remote computer. The examiner notes that

4. The applicant argues that hindsight is used regarding establishing a user ID. The primary examiner disagrees since Moon specifically teaches using the device in a Microsoft Windows environment (C4, L23-38). Windows environments require user ID's and passwords for security purposes and hence Moon's Windows-based system inherently utilizes user ID's/passwords. Further to this point, Moon teaches using Microsoft applications (ie. email, MS Word, Excel, Powerpoint, etc) [see C4, L50-51]. Therefore the device would interface to a file server/email server and inherently control said file/email server (ie. the user "control" the email server to have it download emails, and/or create an email, delete an email, etc.. For MS Word, the user creates a file, modifies it, deletes it, etc.). Also, email alerts can be received by the email server and then be passed to the mobile device.

5. The primary examiner is not swayed by the applicant's argument regarding the "RF transmission means" not being cellular. Firstly, Moon teaches a generic RF transceiver which can be broadly interpreted to encompass cellular, Bluetooth, WLAN, etc.. Moon teaches a wireline interface (C3, L48 and/or Figure 2, #60) which infers that a wireless link could be substituted. The examiner notes that Moon does not limit the transceiver to a specific type and hence one skilled can replace said transceiver with virtually any RF transceiver, to include cellular. The argument regarding "being out of range" is inconsequential since a cellular user can roam out of coverage too.

6. Regarding claim 2 (and 7), Moon teaches use of Microsoft applications which provide means for attaching files. The actual procedure for doing this would be for the user to either do it on the mobile device (eg. client side) and/or do on the email server (eg. server side). Since the operations of Microsoft applications are very well known in the art and readily used by the masses, very little "programming" is required (if at all).

7. Regarding claim 3, the applicant's arguments appear to be against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moon teaches remotely controlling a computer but does not teach sending a fax. Otsuka specifically teaches controlling/sending a fax:

“..Otsuka teaches the communication section and the accessory handset mutually communicate by wireless. That is, the accessory handset is provided with a function as a cordless handset and a function as a cordless remote controller for remotely operating the facsimile terminal equipment (C5, L58-67)...”

8. The examiner recommends amending the claims in a more narrow focus.

9. The original office action (minus claim 1 objection) is attached.

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-9, 11-15 and 17 rejected under 35 U.S.C. 102(e) as being

anticipated by Moon et al. US 6,211,858 (hereafter Moon).

As per **claims 1, 7 and 13**, Moon teaches a system, comprising:

A portable intelligent communications device (eg. cellular telephone/computer – C1, L55-63), having a function for sending messages (C2, L50-53 teaches email alerts which implies having capability to send/receive email via RF link shown in figure 2

#62/64), and having an interface part which commands interface with another computer that is separate from said cellular telephone (C4, L23 to C5, L46 which teaches Microsoft Windows capability for creating/saving files and email which inherently requires connecting to and control of remote file servers and/or email servers), but which can be communicated with via said cellular telephone (figure 5 shows RF transceiver #62/64),

said cellular telephone operating to establish a user identity with said another computer (C4, L23-38 teaches device supporting Microsoft Windows which requires a user log-on event that establishes the identity of the user to a remote server), and

commanding an operation on said remote computer associated with said sending said messages (Moon's teaching of the device using Microsoft Windows, C4 L23-38, and receiving an email alert implies the device can connect to a remote email server and "control it" by creating emails, sending/receiving emails, deleting emails, etc. One skilled would also expect the Windows software to provide creating, editing and storing of files on a remote file server as well).

With further regard to claim 7, Moon teaches Windows which provides the ability to attach a file which may have a "function" associated with it, ie. a user can email a WORD, EXCEL or POWERPOINT document, each having a different function that is launched when said attachment is opened.

As per **claims 2, 9 and 15**, Moon teaches a system as in claim 1/7/13 wherein said enabling an operation comprises enabling attaching a file that on said remote computer along with part of a message being sent from said cellular telephone (Moon's teaching of the device using Microsoft Windows, C4 L23-38, and receiving an email alert implies the device can connect to a remote email server and "control it" by creating emails, sending/receiving emails, deleting emails, etc. One skilled would also expect the Windows software to provide creating, editing and storing of files on a remote file server as well. The examiner also points to figure 3 which shows managing files – NEW, OPEN, SAVE, SAVE AS, PRINT – which imply that the user can create files, send files to a remote computer and also add attachments per known Microsoft Windows capabilities).

As per **claims 4 and 17**, Moon teaches a system as in claim 1, further comprising forming a visual simulation of the layout of the another computer on a display associated with said cellular telephone and enabling selection of a file on said display for said operation (Figure 3 shows the OPEN command which would provide access to local and/or remote memory/disk drives whereby one can use Microsoft Windows to display a visual layout of a file system on said remote computer).

As per **claim 5**, Moon teaches a system as in claim 4, wherein said selection commands attaching said file to a message being sent (C2, L49-53 teaches Email capability and one skilled realizes that the Microsoft Windows-capable device can transmit/receive emails. The device also support Windows file management which allows for attaching of files that are transmitted/mailed).

As per **claim 6**, Moon teaches a system as in claim 2 wherein said message is an e-mail message sent from said cellular telephone (C2, L49-53 teaches Email capability and one skilled realizes that the Microsoft Windows-capable device can transmit/receive emails).

As per **claim 8**, Moon teaches a method as in claim 7, wherein said communicating with the remote computer comprises communicating via a wired/wireless link (figure 2 shows wireless and land link connectivity, #62/#64 and #60 respectively) and the device is loaded with Microsoft Windows (C4, L23-38) which supports TCP/IP and therefore can connect to the Internet.

As per **claim 11**, Moon teaches a method as in claim 7, wherein said communicating comprises using the cellular telephone to contact the remote computer, and requiring a Log-in verification on said remote computer (C4, L23-38 teaches device supporting Microsoft Windows which requires a user log-on event that establishes the identity of the user to a remote server).

As per **claim 12**, Moon teaches a method as in claim 11, comprising forming a visual simulation of the layout of the another computer on a display associated with said cellular telephone and enabling selection of a file on said display for said operation (Figure 3 shows the OPEN command which would provide access to local and/or remote memory/disk drives whereby one can use Microsoft Windows to display a visual layout of a file system on said remote computer).

As per **claim 14**, Moon teaches a method as in claim 13, wherein said operation comprises sending a message using message parts from the portable cellular telephone and message parts from the non-portable computer (C4, L23 to C5, L46 which teaches Microsoft Windows capability for creating/sending/receiving email which inherently requires connecting to and control of remote email server(s)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 10 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Moon as applied to claims 1, 7 and 13 above, and further in view of Otsuka et al. US 6,108,411 (hereafter Otsuka).

As per **claims 3, 10 and 16**, Moon teaches the system as in claim 1/7/13 **but is silent on** wherein said enabling an operation comprises sending a fax using hardware associated with said remote computer.

Otsuka teaches the communication section 15 and the accessory handset 16 mutually communicate by wireless. That is, the accessory handset 16 is provided with a

function as a cordless handset and a function as a cordless remote controller for remotely operating the facsimile terminal equipment (C5, L58-67).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Moon, such that enabling an operation comprises sending a fax using hardware associated with said remote computer, to provide means for using a fax even when remotely located from said fax machine.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
PRIMARY EXAMINER
4-14-05

